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09/736,649	12/13/2000	Mike Sage	MOC02 002	8281
7590 Dianoosh Salchi Duane Morris LLP Suite 700 1667 K Street, N.W. Washington, DC 20006			EXAMINER REFAI, RAMSEY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES

6
7 *Ex parte* MIKE SAGE
8

9 Appeal 2009-0816
10 Application 09/736,649
11 Technology Center 3600
12

13 Decided: ¹ March 30, 2009
14

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16 *Before:* MURRIEL E. CRAWFORD, DAVID B. WALKER, and JOSEPH
17 A. FISCHETTI, *Administrative Patent Judges.*

18
19 CRAWFORD, *Administrative Patent Judge.*
20

21 DECISION ON APPEAL
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23
24
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26 STATEMENT OF CASE

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1, 4, 5, 7 to 9, 13, 32, 33, 37 to 43. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a method for generating a repair order (Specification 1).

1. A method for generating a repair order, comprising:
 - scanning vehicle identifier on a vehicle;
 - obtaining current vehicle mileage with a personal digital assistant (PDA);
 - transmitting the vehicle identifier and said current vehicle mileage over a wireless communication link;
 - retrieving a dataset associated with the vehicle by querying a database as a function of said vehicle identifier, said data set having a vehicle service history and a service list, said service list having a plurality of service items as a function of a mileage, the vehicle history, recommended maintenance, factory recall, and available service campaigns;
 - transmitting said data set to the PDA;
 - displaying said selected service items on the PDA;
 - obtaining user requested service items from said data set wherein the user requested service items are a subset of the data set; and
 - generating a repair order responsive to said user requested service items.

The Examiner rejected claims 1, 4, 5, 7 to 9, 13, 32, 33 and 37 to 43 under 35 U.S.C. § 103(a) as being unpatentable over Li in view of Moore.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Moore	US 6,370,454 B1	Apr. 9, 2002
Li	US 6,609,050 B2	Aug. 19, 2003

ISSUES

Has Appellant shown that the Examiner erred in rejecting the claims because neither reference alone discloses the method of the claims?

Has Appellant shown that the Examiner erred in rejecting the claims because Li and Moore are not concerned with services beyond the immediate repair of the vehicle and as such do not contemplate providing a customized service menu for the customer's review?

Has Appellant shown that the Examiner erred in rejecting the claims because the elements disclosed in Li and Moore are provided for a different reason than the elements of the claimed invention and thus the references could not have provided the solution invented by Appellant?

Has the Appellant shown that the Examiner erred in rejecting the claims because Li does not disclose selecting service items as a function of mileage, the vehicle history, recommended maintenance, factory recall and available service campaign?

FINDINGS OF FACT

Appellant discloses a method of generating a repair order. Appellant states that it would be advantageous for a service writer to have comprehensive and ready access to information about a vehicle and to be able to generate a repair order remotely at the customer's vehicle (Specification 2).

Li discloses a vehicle warranty and repair computer-networked system that includes a database 91 with data fields which include summary,

1 keyword, diagnosis, vehicle information and servicing recommendation (col.
2 4, ll. 13 to 15). A dialog manager 20 collects service information regarding
3 a vehicle from a user through a computer interface 80 (col. 3, ll. 42 to 44).
4 A case-based reasoning module 30 analyzes the service information to
5 determine a pre-diagnosis (col. 3, ll. 49 to 50). The pre-diagnosis can be as
6 general as indicating that routine maintenance is required (col. 3, ll. 60 to
7 62). Routine maintenance is typically done in accordance with the age or
8 mileage of a vehicle. A vehicle quality feedback module 60 monitors
9 servicing issues which includes an equipment configuration module 61 for
10 determining whether the vehicle contains equipment which has been
11 identified as having a particular and/or unique servicing issue (col. 5, ll. 13
12 to 17). The vehicle quality feedback module 60 includes a recall module 62
13 for determining whether the vehicle is under recall (col. 5, ll. 26 to 28). Data
14 regarding the vehicle history based on VIN number is stored and may be
15 displayed (col. 7, ll. 24 to 26). A user can select the service desired from
16 among the services provided (Figures 7 and 10).

17 Moore discloses an automated system for performing routine
18 scheduled maintenance on a vehicle which includes a database for the user
19 or the provider to enter information (col. 1, ll. 7 to 10; col. 10, ll. 3 to 5).
20 Data can be entered through a corresponding personal digital assistant
21 ("PDA"). Data entered may include automobile information related to
22 mileage, maintenance, and service history (col. 10, ll. 1 to 9). The
23 manufacturer can enter data related to recommended service and product
24 recalls (col. 10, ll. 3 to 10).

PRINCIPLES OF LAW

An invention is not patentable under 35 U.S.C. § 103 if it is obvious. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1745-46 (2007). The facts underlying an obviousness inquiry include: Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. In addressing the findings of fact, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR* at 1739. As explained in *KSR*: If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida and Anderson's-Black Rock* are illustrative - a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *KSR* at 1740.

A prior art reference is analyzed from the vantage point of all that it teaches one of ordinary skill in the art. *In re Lemelson*, 397 F.2d 1006, 1009 (1968)(“The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.”). Furthermore, “[a] person of ordinary skill is also a person of

1 ordinary creativity, not an automaton.” *KSR* at 1742. On appeal, Applicants
2 bear the burden of showing that the Examiner has not established a legally
3 sufficient basis for combining the teachings of the prior art. Applicants
4 may sustain its burden by showing that where the Examiner relies on a
5 combination of disclosures, the Examiner failed to provide sufficient
6 evidence to show that one having ordinary skill in the art would have
7 done what Applicants did. *United States v. Adams*, 383 U.S. 39 (1966).

8
9 ANALYSIS

10 We are not persuaded of error on the part of the Examiner by
11 Appellant’s argument that neither Li nor Moore discloses the subject matter
12 of claim 1 because one cannot be establish nonobviousness by attacking the
13 references individually when the rejection is predicated on a combination of
14 prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed.
15 Cir. 1986).

16 We are not persuaded of error on the part of the Examiner by
17 Appellant’s argument that the Examiner erred in rejecting the claims
18 because Li and Moore are not concerned with services beyond the
19 immediate repair of the vehicle and therefore do not contemplate providing
20 a customized service menu for the customer’s review. First, this argument
21 is not commensurate in scope with the recitation of claim 1 because claim 1
22 does not recite “services beyond an immediate repair of a vehicle” or a
23 “customized service menu.” In fact, claim 1 recites “a method for
24 generating a repair order” which is clearly disclosed by Li. In addition, as
25 found above, both Li and Moore disclose the use of the therein disclosed

1 systems to exchange data related to the maintenance of a vehicle. Both
2 references disclose services beyond an immediate repair.

3 We are not persuaded by Appellant's argument that the Examiner
4 erred in rejecting the claims because the elements disclosed in Li and
5 Moore are provided for a different reason than the elements of the claimed
6 invention and thus the references could not have provided the solution
7 invented by Appellant. According to the Appellant, the claimed invention
8 is concerned with providing a customized menu of possible services.
9 However, as we said above, claim 1 does not recite the step of providing
10 a customized menu. Therefore, this argument is not commensurate in
11 scope with the recitations in claim 1. In addition, it is not necessary for
12 the references to be combined to solve the same problem solved by the
13 Appellant, only that there is some reason to combine the references and that
14 the combination produces a predictable result. *KSR* at 1740.

15 We are not persuaded of error on the part of the Examiner by
16 Appellant's argument that Li does not disclose selecting service items
17 as a function of a mileage, vehicle history, recommended maintenance,
18 factory recall and available service campaign. First, this argument is not
19 commensurate in scope with the recitations of claim 1, because claim 1 does
20 not recite a selecting service items step. Claim 1 recites retrieving a dataset
21 associated with the vehicle and obtaining user requested service items. As
22 we found above, Li discloses that the user can request service items and that
23 data related to mileage, vehicle history, maintenance, factory recall and
24 available service campaigns are stored and can be retrieved.

1 In view of the foregoing, we will sustain the Examiner's rejection of
2 claim 1. We will also sustain the Examiner's rejection of claims 4, 5, 7 to 9,
3 13, 32, 33, and 37 to 43, because the Appellant has not argued the separate
4 patentability of these claims.

5
6 CONCLUSION OF LAW

7 On the record before us, Appellant has not shown that the Examiner
8 erred in rejecting claims 4, 5, 7 to 9, 13, 32, 33, and 37 to 43.

9 DECISION

10 The decision of the Examiner is affirmed.

11 AFFIRMED

12 JRG

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